

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and favorable reconsideration of the subject application is requested in view of the comments and/or amendments made herein.

Claims 36-57, 60-70, and 72-80 remain in this application. Claims 58-59 and 71-72 have been canceled.

Claims 39-40, 42-45, 47-49, 56-57, 65-67, 69-70 and 79-80 were rejected under 35 U.S.C. §102(b) as being anticipated by Smithers (U.S. 3,978,642). Claims 37, 52, 58, 62, 71, and 75 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smithers in view of Mally (U.S. 5,391,386). Claims 54, 64 and 77 are rejected as above in further view of LaPlace (U.S. 6,595,739), whereas claims 53, 63, and 76 are rejected as above in further view of Wadell (U.S. 5,336,502). For the following reasons, the rejections are respectfully traversed.

Claim 36, as amended, recites a transfer device for transferring “flaccid food pieces” with the “materials or pieces are held in place by a vacuum”. It is noted that the device of Smithers uses vacuum to transfer a *plastic film*, not flaccid food pieces. As disclosed in Smithers in e.g. col. 3, line 53 – col. 4, line 2, it is the *film* that is delivered to the rotating cylinder body 15 from a roll 28 (e.g. Fig. 1) via a delivering mechanism B and a cutting mechanism, and it is the *film* that is provided to the rotating cylinder body 15. Thus the reference does not teach the cited limitation, and claim 36 is patentable over the reference for at least this reason.

Furthermore, claim 36 recites that “said flaccid food pieces are delivered to said transfer device in an *accumulated* and/or *unordered* form” (emphasis added). In contrast, the section of the reference referred to by the Examiner (col. 4, lines 10 – 20) actually mentions that the bacon slices on the route to the rotating cylinder body are transported while *maintaining the speed and spacing* (col. 4, lines 18 – 19). Thus, if the bacon slices are transported with a spacing and with a speed that is maintained, they can in no circumstances be *accumulated* on the route from the slicer M to the rotating cylinder body

15. Figure 6 of the reference, showing uniformly distributed slices, support this interpretation.

Furthermore, it is not disclosed in Smithers that such pieces are delivered to the rotating cylinder in an *unorderedly* form,. As mentioned above, it is disclosed in Smithers that the bacon slices on the route to the rotating cylinder body are transported while maintaining the speed and spacing (col. 4, lines 18 – 19). Thus, if the bacon slices are transported with a spacing and with a speed that is maintained, they cannot be said to be delivered in an *unorderedly* form on the route from the slicer M to the rotating cylinder body 15. Again, Figure 6 supports this interpretation, as the slices are shown in an orderly manner.

Accordingly, Smithers teaches neither an “unorderedly” nor an “accumulated” manner of providing the pieces to the transfer device, but, in fact, teaches the opposites, and thus claim 36 is patentable over the reference for this reason as well.

Although the Examiner has submitted that the features of claim 37, i.e. that the materials are delivered to the transfer device in an unordered form, is taught by Mally (see page 8, lines 14 – 17 of the Office Action), and that it would be obvious to modify the teaching of Smithers as taught by Mally in this respect, a close reading of the Mally reference fails to support such an argument

When studying Mally, and in particular the part of the specification referred to by the Examiner (Fig. 3, col. 1, lines 40 – 50 and col. 3, lines 55 – 60) it cannot be said that Mally teaches that the product slices are delivered to the transfer drum 30 (cf. fig. 1B and Fig. 2) in an unordered form. On the contrary, Mally describes, see col. 3, lines 52 – 55, that the slices are arranged in a *predetermined pattern* (the opposite of unorderedly), when they are transferred from a first location to a second location, where the first location is the slicing area. This is also apparent when looking at Fig. 2, where the slices are arranged in an orderly pattern (without overlapping each other) on the transfer drum 30, and when reading, e.g., col. 5, lines 41 – 56 of the specification, where it is specified that the slices are cut from a reciprocation magazine 22 comprising multiple food product sticks 27 (thus defining the predetermined pattern), and that the slices after being cut by means of the blade 26 are moved to the transfer drum 30, which is rotating in synchronicity with the

magazine 22, thereby maintaining the predetermined pattern. Accordingly, Mally fails to teach the unorderly delivery, and thus the combination of Smithers with Mally fails to render the claimed features obvious.

Furthermore, it is improper for an Examiner to propose a change to a primary reference that changes the principle of operation of that reference. In this case, the Examiner is attempting to modify Smithers in order to encompass the unorderly provision of items, despite the fact that the reference specifically requires that the items be provided in an orderly fashion by “maintaining the speed and spacing” (col. 4, lines 18 – 19). Forcing the device to provide such items in an unorderly form would violate this requirement and thus change its principle of operation, and thus is not a permitted modification, and thus cannot support a *prima facie* case of obviousness.

Accordingly, claim 36 is patentable over the combination of references, as are claims 37-54, which depend, directly or indirectly, on claim 36.

Claim 55 recites a feature of a “transfer device” for “transferring materials or pieces from a first transport means to a second transport means or to a weighing system, wherein the materials or pieces are delivered to said transfer device via the first transport means in an *unorderly* and *accumulated form*” (emphasis added), and thus is patentable over the references for requiring both an unorderly form and an accumulated form, and thus is patentable over the references for reasons similar to those discussed above for claim 36 regarding these issues, as are claims 56-57 and 60-67, which depend on claim 55. Claim 68, and the claims dependent thereon, are patentable over the references for similar reasons.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. SCAN1-40146.

Respectfully submitted,
PEARNE & GORDON, LLP

Date: January 18, 2010

By: _____ / Robert F. Bodi /
Robert F. Bodi, Reg. No. 48,540

1801 East Ninth Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700